

Appl. No. 10/807,099
Amdt. Dated, 22 June 2006
Reply to Office Action of 24 March 2006

REMARKS/ARGUMENTS

Acknowledgement of Examiner Telephonic Interview

Applicants thank the Examiner for the time spent 05 June 2006 discussing the rejections under 35 U.S.C. §103 with inventor Dr. Jianmin Shi and his undersigned attorney. The discussion helped to clarify the Examiner's position and define what actions must be done to overcome the two 35 U.S.C. § 103 rejections. The Examiner's assistance is appreciated.

Summary of Office Action (OA)

The Office Action of 24 March 2006 acknowledged and accepted the filing of a Request-For-Continued-Examination (RCE) under 37 CFR 1.114). Claims 2-7 are objected to as having informalities in the preamble. Claims 1-11 are rejected as obvious under 35 U.S.C. § 103 (a) over Jarikov (US 2004/0076853) and separately over Jarikov (EP 1359790). In addition, Claims 1-11 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting over Claims 1-11 of co-pending Application 10/807,130 (ARL 04-16-Shi) in view of JP 08199162A.

Claims 1-11 are pending. Applicants by this Amendment have attempted to place the application in condition for allowance.

Acknowledgement of Acceptance of RCE

Applicants acknowledge and thank the Examiner for the acceptance of the Continued Examination under 37 C.F.R. § 1.114 and the entrance of the amendment.

Response to Claim Objections

Claims 2-7 are objected too because the preamble of the Claims is inconsistent with the preamble of Claim 1. Suitable amendment has been made. Applicants believe the amendments abrogate the rejection.

Response to the 35 U.S.C. §103 Rejections

Over Jarikov US 2004/0076853

Claims 1-11 are again rejected under 35 U.S.C. § 103 as un-patentable in view of Jarikov (US 2004/0076853) (Jarikov US Pub). Applicants respectfully traverse this rejection. The Jarikov US Pub presents a myriad of different compounds and luminescent materials without teaching or recognizing the use of the claimed anthanthrene derivatives as a luminescent dopant material. Specifically, the Jarikov devices of both the Jarikov US Pub and the Jarikov EP '790 teach a two component host material and a dopant. In addition, Jarikov Pub does not teach that the anthanthrene derivatives standing alone as the dopant. Applicants claim and teach the anthanthrene derivatives as the sole luminescent component. Support for the claimed limitations are found in paragraph [Example 17 *et seq.* 0175+; & Example 18 [0184+] & FIG 4, FIG 5 and Table 2 *et seq.*] of the specification as published in Shi Patent Publication 2005/0214566. The specific examples of the instant application show actual test results and comparisons that are reflected in the tables and figures of the instant

Appl. No. 10/807,099
Amdt. Dated, 22 June 2006
Reply to Office Action of 24 March 2006

application. The claims as presented are distinguished from Jarikov Pub and these claims are now believed to be in condition for allowance.

Over Jarikov EP 1,359,790

Claims 1-11 are rejected as obvious under 35 U.S.C. § 103 (a) over Jarikov (EP 1359790) (Jarikov EP'790). Applicants respectfully traverse this rejection. The Jarikov EP'790 is related to the Jarikov US Pub as parent (EP) to child CIP (US Pub). The disclosures are substantially similar. The arguments presented in response to the previous rejection are equally applicable to the instant rejection over Jarikov EP and are incorporated herein by reference. The claims as presented are distinguished from Jarikov EP and these claims are now believed to be in condition for allowance.

Response to Obviousness Double Patenting Provisional Rejection

Applicants respectfully traverse this "Provisional Double Patenting" rejection. Application 10/807,130 (ARL 04-16) is related to the instant Application 10/807,099 (ARL 04-17) as compounds *per se* to a specific application of those compounds for one among several uses. The two applications are assigned to different examiners and are separately classified. If Applicant had included both in one application, the USPTO would have required division. Because the two applications are so patentably distinct there is no basis for even a "Provisional" rejection on these grounds. The rejection is inapplicable to this application. By serial number, this application was filed first. The 10/807,130 has not, as yet, received review. Both applications were filed the same date. Under 20 years from date of filing, both expire the same date. There is no practical effect on the term of this application even if Applicants comply with this rejection. The rejection should be withdrawn from this application.

In the interests of moving prosecution forward, Applicants, by their Attorney, provide the following "Provisional Terminal Disclaimer".

PROVISIONAL TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION

The United States of America, by the Secretary of the Army through his duly appointed Attorneys, owner of the entire right, title and ownership in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number 10/807,130 filed on 23 March 2004 (Atty. Docket No. ARL 04-16), as such term is defined in 35 U.S.C. §§ 154 & 173, and as the term of any patent granted on said reference application may be shortened by any disclaimer filed prior to the grant of any patent on the pending reference application. The Government hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, or assigns.

Appl. No. 10/807,099
Amdt. Dated, 22 June 2006
Reply to Office Action of 24 March 2006

In making the above disclaimer, the Government does not disclaim any part of the patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 & 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application," in the event that: any such patent: granted on the pending reference application: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

The undersigned is a duly appointed attorney to prosecute the instant application and believes he is authorized to sign this disclaimer.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Director is hereby authorized to charge any additional fees for underpayments under 37 C.F.R. § 1.16 & 1.17; and credit any overpayments to Deposit Account No. 19-2201 held in the name of U.S. Army Materiel Command.

Certificate of Transmission under 37 CFR § 1.8

I hereby certify that the above AMENDMENT AND RESPONSE TO 1ST OFFICE ACTION IN RCE FILED UNDER 37 CFR 1.114 is being facsimile transmitted to Phone No. 571-273-8300 at the United States Patent & Trademark Office on Thursday, June 22, 2006.

Respectfully submitted,
Intellectual Property Counsel
U.S. Army Research Laboratory

By 

A. David Spevack
Reg. No. 24,743
Tel.: 301-394-1714
FAX: 301-394-3972
e-mail: dave.spevack@us.army.mil

ATTN: AMSRD-ARL-0-CC-IP
2800 Powder Mill Road
Adelphi, Maryland 20783-1197